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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,229	05/19/2000	Toru Chiba	P19101	7775

7055            7590            08/06/2002

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 08/06/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicant No.</b>	<b>Applicant(s)</b>	
	09/574,229	CHIBA, TORU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Donald Heckenberg	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 July 2002.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 May 2000 is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

Art Unit: 1722

1. Applicant's election with traverse of Group I (claims 1-5) in Paper No. 5 is acknowledged. The traversal is on the ground(s) that there is no serious burden in examining the two distinct inventions together. This is not found persuasive because although there is some overlap in search of the two distinct inventions, there are significant areas in classes 249 and 425 which are required for the search of Group I, but not Group II. Similarly, there are significant area of class 264 which are required for the search of Group II, not Group I. Therefore, there would be a serious burden in examining the two distinct inventions together.

The requirement is still deemed proper and is therefore made FINAL.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p) (5) because they include the following reference sign(s) not mentioned in the description: #5a (fig. 2). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 1722

3. The disclosure is objected to because of the following informalities:

P. 5, lns. 20-25 recite "an upper cylindrical holder 6 capable of securely holding the base member 11 therein... [and] a lower cylindrical holder 3 arranged to be opposed to the upper cylindrical holder 6 and capable of securely holding the transfer die 4[.]" Based on figure 1 of the drawings, it appears as though the numbers for the holders are reversed. In figure 1, the upper cylindrical holder 6 holds the transfer die 4, and the lower cylindrical holder 3 holds the base member 11.

Appropriate clarification and/or correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 5 rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Pub. No. 01-218808 (hereinafter "JP '808").

JP '808 teaches a lens molding die comprising a base member (11 and 12) made of a hard material and having a predetermined

Art Unit: 1722

shape, a resin-molded surface layer (21) formed on one side of the base member and having a surface shape corresponding to a predetermined shape of one surface of a lens to be produced. JP '808 further teaches the predetermined shape of the one surface of the base member to be spherical while the surface shape of the resin-molded surface layer is aspheric or non-spherical (see abstract). JP '808 further teach the surface layer to be made of ultraviolet curable resin material (see abstract). Depending on the intended use of the apparatus, the surface layer of the would inherently be inactive with a material to be molded by the lens molding die, as particular molding materials would not react with the UV curable resin described by JP '808. Note as well that it is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963).

6. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Singh et al. (US Pat. No. 5,204,126).

Art Unit: 1722

Singh teaches lens molding die comprising a base member (I) made of a hard material and having one surface of a predetermined shape, and a resin molded surface layer (40) formed on one surface of the base member and having a surface shape corresponding to a predetermined shape of one surface of the lens to be produced. Singh further teaches the surface layer to be inactive with the material molded in the die as the surface layer does not become part of the molded product, but can be used multiple times (see col. 8, lns. 61-69). Singh further teaches the surface layer to be a thermosetting material (col. 6, lns. 30-41).

7. The following reference is cited, but not relied upon, is pertinent to the instant application:

Ishihara et al. (US Pat. No. 6,315,929) teaches a mold assembly for forming lens comprising a base member (8) and a resin surface layer (10).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

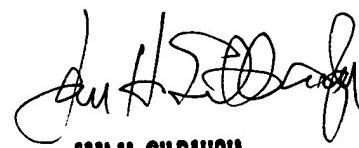
Art Unit: 1722

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jan Silbaugh, can be reached at (703) 308-3829. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.

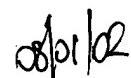
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Donald Heckenberg  
July 30, 2002



JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
ART UNIT 1722



08/01/02